



Docket No. 0826.1729

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mayumi TOMIKAWA, et al.

Serial No. 09/879,098

Group Art Unit: 2681

Confirmation No. 3219

Filed: June 13, 2001

Examiner: Thjuan Knowlin

For: APPARATUS AND METHOD FOR GENERATING A DATA DISTRIBUTION ROUTE

PETITION TO DIRECTOR
REQUESTING WITHDRAWAL OF FINALITY OF ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition requesting that the finality of the Action mailed November 17, 2005 be withdrawn as premature and improper.

I. Background

On or about July 26, 2004, applicant filed an Amendment of the claims.

In response thereto, Examiner Knowlin issued/mailed a first final Action on November 18, 2004. This first final Action was properly made final because of the amendment of the claims. This first final Action rejected all claims as anticipated by Naudus.

On March 9, 2005, an Interview was conducted with Examiner Knowlin and Examiner Matar in which an argument was presented that Naudus does not teach or suggest, among other things, multicasting. Based on the argument presented in the Interview agreement "was reached" and Examiner Knowlin withdrew the (final) Action rejection noting that a new Action would be issued. The withdrawal of the rejection based on the argument made in the Interview is documented in the Interview Summary of record. As stated in the Interview Summary:

Applicant's representative explained that the claims recite "multi-casting" of "streaming data" based on/responsive to communication cost. It appears that the multi-hop teachings in Naudus is different from the claimed multi-cast feature. The Final office action (11/18/04) is now withdrawn. Examiner will update the search and issue a new office action.

(See Interview Summary, 3/9/5)

On November 17, 2005 the Examiner issued a second final Action in which all claims were rejected over newly cited Kodialam. In this second final Action in paragraph 13, on page 5 the Examiner stated the reason for making the Action final as: "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action."

It is requested that the finality of this second final Action of November 17, 2005 be withdrawn as premature and improper.

II. Argument

II.A. The Basis For Finality Is Without Support In The Record

The Examiners stated reason for making the Action of November 17, 2005 final is incorrect as demonstrated by the text of the Interview Summary. It is requested that the finality be withdrawn because the basis for making the Action final is faulty and without support in the record.

II.B. Making The Action Final Contravenes Present Office Practice

By withdrawing the first final Action rejection based on Naudus and issuing a rejection based on Kodialam, the Examiner has raised a new ground of rejection. The first final Action was withdrawn and second final Action was issued as necessitated by the argument presented at the Interview. That is, the withdrawal of the first final Action and the issuance of the second final Action was not necessitated by the amendment of the claims by the applicant but rather by the argument presented at the Interview.

MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(e) with the fee set forth in 37 CFR 1.17(p).

(See MPEP 706.07 (a))

It is submitted that the Action issued November 17, 2005 is not properly final under the above-identified section 706.07 (a) of the MPEP because the new ground of rejection was not necessitated by applicant's amendment. For this further reason, it is requested that the finality of the Action be withdrawn.

II.C. Making The Action Final Contravenes The Purpose of a Final Action

The purpose of a final action is to reach a clear issue with the Applicant:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

(See MPEP 706.07)

It is submitted that a clear issue has not been reached with the Examiner since the Applicant has not had an opportunity to respond to the new grounds of rejection that were not necessitated by applicant's amendment of the claims but rather necessitated by the argument presented at an Interview.

It is submitted that the Action issued November 17, 2005 is not properly final under the above-identified section 706.07 of the MPEP. For this additional reason, it is requested that the finality of the Action be withdrawn.

II.D. The Involved Examiners Have a Misunderstanding of the Bases of a Final Action

The undersigned contacted the Examiner Knowlin about this issue via email on January 9, 2006 (copy attached). The Examiner telephoned on January 10, 2006 and a telephone discussion was conducted with Examiner Knowlin on this issue of whether the finality was proper. In the telephone conversation, Examiner Knowlin indicated that the finality of the November 17, 2005 Action was proper because the claims had been previously amended, that the first final Action was properly made final and therefore the second final Action was also properly made final. The Examiner also graciously indicated that we could speak with Supervising Examiner Matar.

On January 10, 2006, we spoke with Examiner Matar who indicated the finality was proper on the same basis. Examiner Matar graciously indicated that we could speak to Examiner Bost of Quality Review. We spoke to Examiner Bost on January 10, 2006 and Examiner Bost essentially repeated the rationale of Examiners Knowlin and Matar.

It was pointed out to Examiner Bost that the withdrawal of the first final Action was not necessitated by applicant's amendment of the claims but rather necessitated by an argument presented at an Interview. During this discussion with Examiner Bost, it was pointed out that if the applicant had filed a Response (where the claims were not amended and which made the argument concerning the lack of multicasting in Naudus) and Examiner Knowlin had similarly issued a new Action based on the filing of such a paper, that it would not be proper for Examiner

Knowlin to have issued a second final Action but Examiner Knowlin would have instead been required to issue a non-final Action. Examiner Bost acknowledged that this was the case.

In other words had the applicant presented the same argument presented in the Interview of March 9, 2005 in a filed paper Response, the finality of the second final Action would not be proper.

A technical distinction between filing a paper and presenting an oral argument is submitted to not be a proper basis for making an Action final. Withdrawal of the finality of the Action for this reason is requested.

III. Conclusion

It is submitted that Action issued November 17, 2005 is not properly final for the reasons discussed above.

It is requested that the finality of the Action mailed November 17, 2005 be withdrawn.

It is not believed that any fee is necessary for this Petition. However, if any fee, other than and except for the issue fee, is necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.


Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

1/12/06

By: _____


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Randy Beckers

From: Randy Beckers
Sent: Monday, January 09, 2006 5:24 PM
To: 'thjuan.knowlin@uspto.gov'
Subject: 09/879,098 / 826.1729

Contacts: Thjuan Knowlin

Examiner Knowlin:

The action in this case has been made final. However, I do not think it is properly made final and want to double check. We did not amend the claims, the final action was withdrawn as a result of an interview and a new (not previously cited) reference was used to reject the claims.

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

See http://www.uspto.gov/web/offices/pac/mpep/documents/0700_706_07_a.htm#sect706.07a

Am I correct?

If so, do we need to formally request that the finality be withdrawn? Or can you do it via an Interview Summary? Or reissue the action?

Please telephone me to discuss if needed.

Randy

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